REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1-27 are pending in the instant application, with claims 1, 12, 26, and 27 being independent. Claims 25-27 have been added by this amendment, which do not add any new subject matter.

Interview Summary

Applicants would like to thank the Examiner, Huedung X Cao, and her Supervisor, Mark Zimmerman, for the personal interview that was conducted on February 26, 2004 (Applicants note that the Interview Summary Sheet states February 25, 2004, which appears to be a typographical error). During the interview, Applicants demonstrated features of the present invention with the use of an image display apparatus, e.g. a monitor and a projector. Applicants also discussed the patentable features of the pending claims in view of the cited art and proposed amendments to the claims. The Examiner stated that, based on our discussion, that the claims appear to overcome the rejections.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication on

B

page 5 of the Office Action that claims 2-3, 10-11, 14-15, and 23-24 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. For at least the reasons detailed below, Applicants respectfully submit that all pending claims should be considered allowable.

Information Disclosure Statement

Information Disclosure Statements and accompanying PTO-1449 forms were filed on December 8, 2000, March 15, 2001, March 4, 2002, and December 16, 2002. There is presently no indication that the Examiner considered the documents identified in the Information Disclosure Statements that were filed on December 8, 2000 and December 16, 2002. Accordingly, the Examiner is respectfully requested to acknowledge consideration of the documents identified in those Information Disclosure Statements by initialing the PTO-1449 forms and returning a copy of the initialed forms to the undersigned.

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1, 4-9, 12-13, and 16-22 under 35 U.S.C. §103(a) as being obvious in view of *Kagawa* et al. (US Patent 5,917,959). This rejection is respectfully traversed insofar as it

B

pertains to the presently pending claims.

Regarding the applied rejection against independent claim 1, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

The Examiner states, in rejecting claim 1 under 35 U.S.C. §103, that "it would have been obvious for Kagawa's color conversion process...to implement a matrix calculation by using said calculation terms effective just for the specific hues because the improvement of color characteristics through a linear relationship representable by a matrix enhances the quality of the display image." Applicants respectfully submit that this conclusionary statement made by the Examiner is not a proper basis to substantiate an obviousness rejection.

Recent Federal Circuit case law precedent makes it explicitly

B

clear that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, but must be read on the objective evidence of the record. Federal Circuit case law precedent further requires that "common sense and common knowledge" alone is improper evidence in support of an obviousness rejection.

The Examiner purports a common sense and common knowledge reason for the deficiencies of the cited art. However, common sense and knowledge are not objective evidence of record, as the Federal Circuit explains, but are in fact commensurate with subjective belief and unknown authority. Therefore, the Examiner has failed to meet the legal requirements to substantiate the obviousness rejection.

For an illuminating discussion on the burden placed on an Examiner to establish objective factual findings of record, the Examiner is referred to the recent Federal Circuit decision of *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

In re Lee involved an appeal of a decision of the Board of Patent Appeals in which Lee argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to these arguments by ruling that "[t]he

B

conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." Id. at 1432. The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the administrative procedure act." Id. at 1431. The Federal Circuit further stated that "the factual inquiry whether to combine references must be thorough and searching...it must be based on objective evidence of record...[t]his precedent has been reinforced in a myriad of decisions and cannot be dispensed with." Id. at 1433. The Court also stated that the USPTO is "not free to refuse to follow Circuit precedent" and "cannot rely on conclusionary statements when dealing with particular combinations of prior art and specific claims." Id. at 1434.

As stated herein above, the Examiner's asserted modification for *Kagawa* et al., which is "to implement a matrix calculation," and the lack of factual support thereof comports very closely to the analysis disapproved by the Federal Circuit in *In re Lee*. As such, the Examiner's failure to provide factual support for a teaching, suggestion or motivation to modify *Kagawa* et al. constitutes legal error.

Although the rejection against independent claim 1 is

improper, as stated above, Applicants have amended claim 1 in an effort to emphasize a feature of the present invention, e.g., that a user designates the chroma of the color. This amendment has not been made in order to overcome the rejection against claim 1, as discussed above, but has been made in an effort to merely clarify the claim.

Regarding independent claim 12, Applicants have amended claim 12 to include the feature that a user designates the chroma of the color represented by the second image data by the chroma designation means, in an effort to clarify the claim.

Dependent claims 4-9, 16-22, and new claim 25 should be considered allowable at least for depending from an allowable base claim.

Accordingly, in view of the above comments, Applicants respectfully request that the Examiner withdraw the rejections and indicate claims 1-25 as being allowed.

Lastly, new claims 26 and 27 should be considered allowable at least because the cited art fails to teach or suggest the combination of elements including: an adjuster for a user to designate an adjustment value of at least one of six color components of red, green, blue, yellow, cyan and magenta of the first image, and a color converter for converting chroma, whereby

the color converter as recited in claim 26 converts the chroma of the first image based on an adjustment value without substantially effecting another one of six color components, and the color converter as recited in claim 27 converts the chroma of only one of the color components of the first image based on the adjustment value.

Conclusion

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, which is located in the Washington, DC area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____
Martin R. Geissler, Reg. No. 51,011

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

MRG:tm
1190-00478P

Attachment: PTO 1449 forms (2)

B